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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,056	12/04/2000	Pascal Arnaud	200436US0	3932
22850	7590	03/24/2004		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER WANG, SHENGJUN				
ART UNIT		PAPER NUMBER		
1617				

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,056

Applicant(s)

ARNAUD, PASCAL

Examiner

Shengjun Wang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 18, 2003 has been entered.

Applicants' election with travers of the species in paper No. 8 is presumed to carry over to the instant RCE since applicants have not indicated a contrary intention.

The claims have been examined insofar as they read on the elected species.

Claim Rejections 35 U.S.C. 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walling et al (US Pat. 5,948,394) in view of Jakobson et al (US Pat. 5,093,043).

Walling teaches transfer-resistant lip compositions. The compositions resist transfer upon subjecting the wearer to routine or daily activities. The compositions are in the form of Lipstick (see abstract). The compositions comprise lipophilic materials and a variety of other components (see claims 1-6). Walling teaches that a preferred volatile hydrocarbon fluid for use in the invention is isododecane (see col. 4, lines 1-16, and col. 6, line 15 through col. 7, Line 45*, examples 1-6). Walling further teaches that a particularly useful silicone fluid for use in the

invention is available as the 556 series from Dow Corning (see col. 5, lines 3-9). DC 556 is a trade name for phenyltrimphthicone. Walling further teaches that phenyltrimethicone is a most preferred fluid for the invention (see col. 5, Lines 17-20). Walling teaches that various surfactants may be employed in the composition. Examples 1-6 are further comprised of wax and pigments. Additionally, examples 1-4 and 6 contain polyglycerol diisostearate.

Willing does not teach expressly the particular percentages of each ingredients, or expressly states the employment of diglyceryl diisostearate.

However, Jakobson teaches a process for preparing nonionic surfactants. The reference relates to the use of certain nonionic polyglycerol fatty acid ester surfactants as additives or solvents for skin protection agents and skin care oils and for cosmetic formulations (see col. 3, line 47 through col. 4, line 11). Jakobson teaches that diglycerol difatty acid esters have improved properties as compared to polyglycerol esters (see col. 4, lines 54-64). Jakobson specifically compares diglycerol diisostearate with commercial polyglycerol diisostearate (see col. 5, lines 17-20). Jakobson further disclosed that commercial polyglycerol diisostearate is essentially diglycerol diisostearate. See column 5, lines 24-28.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a lip cosmetic composition comprising isododecane, phenyltrimphthicone, and diglycerol diisostearate (such as those disclosed by Jakobson) in a percentage as herein cited.

A person of ordinary skill in the art would have been motivated to make a lip cosmetic composition comprising isododecane, phenyltrimphthicone, and diglycerol diisostearate (such as those disclosed by Jakobson) in a percentage as herein cited because all of the ingredients are

known to be useful in lip composition. As to the particular percentage, note where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Walling by the substitution of diglycerol diisostearate for polyglycerol diisostearate as taught by Jakobson in order to benefit from the improved properties of diglycerol diisostearate as taught by Jakobson.

Response to the Arguments

3. Applicants' remarks submitted November 18, 2003 have been fully considered, but are not persuasive for reasons discussed below.

With respect to the remarks about Walling reference, applicants erred in that taking the specific examples as the only teachings, ignoring all the other disclosure therein. As stated above, "Walling further teaches that a particularly useful silicone fluid for use in the invention is available as the 556 series from Dow Corning (see col. 5, lines 3-9). DC 556 is a trade name for phenyltrimphthicone. Walling further teaches that phenyltrimethicone is a most preferred fluid for the invention (see col. 5, Lines 17-20)." Applicants also erred in considering polyglycerol diisostearate and diglycerol diisostearate as separated, unrelated subject matter. Plain meaning of "polyglycerol diisostearate" would encompass "diglycerol diisostearate." Further, to an ordinary skilled artisan in cosmetic art, "polyglycerol diisostearate" would be essentially same as "diglycerol diisostearate" since commercial "polyglycerol diisostearate" are "condensed from glycerol with approximately two units of glycerol esterified with two moles of isostearic acid." (Jakobson, column 5, lines 24-28).

With respect to the remarks about Jakobson's reference, applicants again erred in taking a part of the teaching as the whole teaching. Particularly, Jakobson does not limit the utility of the diglycerol diisostearate as emulsifier in W/O or O/W composition. In fact, Jakobson specifically states "The use of the surfactants refers preferably to their use as additives, wetting agents, dispersants, solubilizing agents, solvents and emulsifiers for skin protection agents and skin care oil,..." (Jakobson column 4, lines 4-11). Note, question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. In re Lamberti and Konort (CCPA), 192 USPQ 278.

As discussed above, a prima facie case of obviousness has been established. Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.132 must compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case of obviousness. See, MPEP 716.02 (e).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

SHENGJUN WANG
PRIMARY EXAMINER


Shengjun Wang

March 19, 2004